

REMARKS

This paper is filed responsive to the Office Action mailed July 17, 2006; a Petition for Extension of Time for one month is being filed herewith. Presently, Claims 10 and 12-26 are pending in the application. The Terminal Disclaimer filed October 17, 2005 has not been accepted. The drawings stand objected to. Claim 11 stands objected to. All of the claims stand rejected on the grounds of obviousness-type double patenting over Claims 1-47 of U.S. Patent No. 6,360,595 to Lin et al. Claim 11 stands rejected under 35 U.S.C. § 112 second paragraph. All the claims stand rejected under 35 U.S.C. § 103(a) as being obvious over the Wainwright U.S. Patent No. 5,171,537 in view of the Moriarty U.S. Patent No. 6,045,757. Applicants respectfully traverse the rejections and request reconsideration and re-examination of the Application.

The Examiner has objected to and rejected the Terminal Disclaimer filed October 17, 2005 on the grounds that there is no submission in the record establishing the ownership interests. The Examiner also indicated that a “Statement under 37 C.F.R. 3.73(b)” form was included with the Office Action. Applicants did not find such form with the Office Action. However, both the present application and U.S. Patent No. 6,360,595 are assigned to Ethicon, Inc. on an Assignment recorded at Reel 012254, Frame 0688. If it is necessary to establish this by the formality of the aforementioned form, Applicants would be happy to comply upon receipt of the form.

The Examiner has objected to the drawings. The Examiner asserts that the screw is not shown in Figure 5. Applicants respectfully disagree. The screw is clearly shown on Figure 5. Applicants point the Examiner to the helical threads. The Examiner has also objected to Figures 3A-D as being hard to understand. In particular, the Examiner objects to the figures showing in an isolated fashion the coupling of the membrane barrier to the pipette and syringe rather than showing a complete syringe having such slideable couplings. Applicants submit that the drawings are in fact perhaps clearer with this being shown in isolation rather than showing the entire syringe by thus allowing a more detailed view of the coupling which is the important aspect of the drawings. Applicants find these objections

particularly perplexing given that three other applications containing the same drawings and description have previously granted, namely, U.S. Patent Numbers 6,360,595, 6,629,468 and 7,073,401. Accordingly, Applicants request the Examiner to reconsider and withdraw these objections.

The Examiner has both objected to Claim 11 and rejected it under 35 U.S.C. § 112, second paragraph. Claim 11 has been canceled by the present Amendment.

The Examiner has rejected all of the claims on the grounds of obviousness-type double patenting over Claims 1-47 of the '595 patent to Lin et al. The previously submitted Terminal Disclaimer over this patent has been rejected based upon a failure in the record to establish common ownership. However, as described above, both the present application and the '595 patent are assigned to Ethicon, Inc. on an Assignment recorded at Reel 012254, Frame 0688. With this information, Applicants submit that the rejection is now moot.

The Examiner has rejected all of the claims under 35 U.S.C. § 103(a) over Wainwright and Moriarty. Applicants submit that there is no suggestion for making the alleged combination. The Examiner suggests that one of ordinary skill in the art would be motivated to modify the device of Wainwright with the filter of Moriarty in order to prevent contamination and have a securely mounted membrane within the pipette tube. Of course, the reasoning that one of ordinary skill in the art would be motivated by wanting to have a securely mounted membrane within the pipette tube is circular as Wainwright lacks such a membrane. Furthermore, the Examiner suggests that a filter would be desirable to prevent contamination. Applicants fail to find where in Wainwright contamination is of such concern. Wainwright merely desires to draw sufficient fluid into the pipette to reach its sample. In describing Wainwright, the Examiner says that "Wainwright does not disclose that the barrier is vapor or gas permeable but liquid impermeable does not disclose a coupling device or to adapt the barrier to the testing device." Which barrier of Wainwright is this? Applicants fail to see a barrier within Wainwright. Applicants respectfully submit that the Examiner has failed to establish a *prima-facie* case of obviousness by failing to provide a proper suggestion or motivation for making the alleged combination.

Applicants submit that the application is presently in condition for allowance. Favorable reconsideration and early Notice of Allowance of the application are earnestly solicited. If it would speed prosecution, the Examiner is encouraged to contact the undersigned attorney by telephone at the number listed below.

Respectfully submitted,

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